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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,483	03/23/2001	Kunio Sekiya	24555-001	6972

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EXAMINER

HALPERN, MARK

ART UNIT PAPER NUMBER

1731

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/486,483

Applicant(s)

SEKIYA, KUNIO

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006 and 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- 1) Acknowledgement is made of Amendments received 6/16/2006 and 7/24/2006.

Claims 2, 7 are amended, claims 3-5 are cancelled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2) Claims 2, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaoru Kamogawa (JP-4-130190) in view of Donnelly (3,014,832).

Claim 2: Kaoru discloses a method of cleaning a surface of a papermaking rotating dryer drum wherein a release agent, an emulsified silicone oil solution, is applied to the surface of the drum by direct spraying onto the surface. The oil first forms a film on the surface of the drum and then is absorbed by fibers of a paper strip, which rides on the drum. Kaoru, in Example 3, discloses continuous spraying at a rate of 2.0 l/min. onto a surface of a Yankee drum dryer, the dryer having a width of 3 meters, without staining the paper strip by the release of the oil (Kaoru, translation, pages 2-5). Kaoru fails to disclose the drying cylinder linear rotation speed, data that would permit to calculate the spray rate in units claimed. Donnelly discloses a process wherein a dryer surface is kept clean by the release spraying of silicone containing emulsified oil (col. 3,

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lines 15-20, col. 5, lines 1-22) onto the surface of the drum (Donnelly, col. 7, line 50 to col. 8, line 30, and Figure 2). Donnelly discloses drying cylinder drum rotation of up to 3000 feet per minute (Donnelly, col. 6, lines 55-60). Utilizing the Donnelly dryer rotation, the Kaoru method of cleaning calculates a spray rate of about 0.72 mg/m^2 per minute, which is within the claimed range. It would have been obvious to one skilled in the art at the time the invention was made, to combine the teachings of Kaoru and Donnelly, because such a combination would improve the control of adhesion of the web to the dryer surface thus improve the quality of the Kaoru product as disclosed by Donnelly (col. 2, lines 50-68). Kaoru discloses a surfactant added to the silicone oil (Pg. 1, claim 1). Water addition is disclosed by Donnelly (col. 4, lines 31-35). It would have been obvious, to one skilled in the art at the time the invention was made, to dilute the oil with heated water, since the cylinder drum of Donnelly operates at elevated temperatures (Examples 1, 2).

Claim 7: see above described under claim 2, since the drum of a dryer is also a roll. It would have been obvious to one skilled in the art, that the silicone oil be replenished upon depletion.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3) Claims 2, 7, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,858,113.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present application and the patent disclose a method for preventing contamination of a surface of a dryer drum used in a papermaking machine that includes the treatment of the rotating drum surface while facing a paper strip, with a surfactant containing oil at the rate of spray application that is within the range claimed.

4) Claims 2, 7, are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 09/806,020. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present application and the patent disclose a method for preventing contamination of a surface of a dryer drum used in a papermaking machine that includes the treatment of the rotating drum surface while facing a paper strip, with a surfactant containing oil at the rate of spray application that is within the range claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Amendment

5) Applicant's arguments filed 6/16/2006, have been fully considered but they are not persuasive.

Applicant alleges that the invention addresses a method of preventing contamination of a canvas and that the cited prior art, Kaoru, discloses a method of cleaning the surface of a rotating dryer drum.

Kaoru recites the steps of the invention and further, it would have been obvious to one skilled in the art at the time the invention was made, that the method steps of Kaoru, of cleaning of the surface of the dryer would prevent the contamination of the canvas of the present invention.

In regard to the provisional obviousness-type double patenting rejections, the examiner maintains that the although the conflicting claims are not identical, they are not patentably distinct from each.

Conclusion

6) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Taichi Kuroda et al. (JP 7-292382) teaches of a contamination adhesion prevention agent for use in a papermaking drying process by applying a silicone containing oil to a rotating drum or other parts.

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7) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 571-272-1190. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Mark Halpern
Primary Examiner
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